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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/705,707	11/06/2000	Masaki Kyojima	107750	7854

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EXAMINER

WORJLOH, JALATEE

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 10/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/705,707

Applicant(s)

KYOJIMA ET AL.

Examiner

Jalatee Worjloh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 8-22 is/are rejected.
- 7) ☒ Claim(s) 5-7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-22 have been examined.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 9, 16 and 20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to a process that does nothing more than manipulate an abstract idea. There is no practical application in the technological arts. All that is necessary to make a sequence of operational steps a statutory process within 35 U.S.C. 101 is that it be in the technological arts so as to be in consonance with the Constitutional purpose to promote the progress of "useful arts." *In re Musgrave*, 431 F.2d 882, 167 USPQ 280 (CCPA 1970). Also, a claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result: i.e. the method recites a step or act of producing something that is concrete, tangible and useful. *See AT&T v. Excel Communications Inc.*, 172 F.3d at 1358, 50 USPQ2d at 1452.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claims 9 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The steps must be clearly and positively specified; that is, it must be organized and correlated in such a manner as to present a complete operative method/system. Applicant claims the step of "receiving a first request for booking certificate..." and "preparing a second request for booking certificate., which is a request for the issuance of the booking certificate requested with the accepted first request for booking certificate"; the difference between the first and second request is unclear. Applicant is required to revise claims 9 and 10 to precisely clarify and differentiate the first request and second request. The current arrangement of these claims is confusing to the readers and may be interpreted as the same request; therefore, please consider revising.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 2, 8-11 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6309277 to Vaeth et al.

Vaeth et al. disclose preparing verification information required for verifying the legitimacy of a certificate, inputting information for identifying the verification information, preparing a certificate verifiable with the verification information identified by the inputted

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information for identifying verification information; and outputting the certificate thus prepared (see col. 6, lines 13-25 and col. 8, lines 6-13). Vaeth et al. do not expressly disclose a booking certificate; however, such certificate can be inferred. That is, Vaeth et al. define a certificate as information issued by a certificate authority, an entity (e.g. vendors and their potential customers) generally holding a position of trust that authenticates or certifies a transaction (see col. 1, lines 32-45). It is known in the art that customers can make advance purchase and in turn receive a ticket/receipt, hence, certificate. Thus, the examiner presumes that the certificate of Vaeth et al. may include a certificate of advance purchases, i.e. "booking certificate"; also, modifying the certificate of Vaeth et al. will not alter nor depart from the scope of their invention. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art modify the certificate of Vaeth et al. to include a booking certificate. One of ordinary skill in the art would have been motivated to do this because it provides a system/method for qualifying requests for and issuing certificates that may be used to authenticate electronic transactions (see col. 5, lines 35-37).

Referring to claim 2, Vaeth et al. disclose verification information preparing means for preparing verification information required for verifying the legitimacy of a certificate, verification information output means for outputting the verification information prepared by the verification information preparing means, certificate preparing means, to which information for identifying the verification information is inputted, for preparing a certificate verifiable with the verification information identified by the input; and certificate output means for outputting the certificate prepared by the certificate preparing means (see col. 6, lines 13-25 and col. 8, lines 6-13). Vaeth et al. do not expressly disclose a booking certificate; however, such certificate can be

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inferred. That is, Vaeth et al. define a certificate as information issued by a certificate authority, an entity (e.g. vendors and their potential customers) generally holding a position of trust that authenticates or certifies a transaction (see col. 1, lines 32-45). It is known in the art that customers can make advance purchase and in turn receive a ticket/receipt, hence, certificate. Thus, the examiner presumes that the certificate of Vaeth et al. may include a certificate of advance purchases, i.e. "booking certificate"; also, modifying the certificate of Vaeth et al. will not alter nor depart from the scope of their invention. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art modify the certificate of Vaeth et al. to include a booking certificate. One of ordinary skill in the art would have been motivated to do this because it provides a system/method for qualifying requests for and issuing certificates that may be used to authenticate electronic transactions (see col. 5, lines 35-37).

Referring to claim 8, Vaeth discloses encrypting public key pair preparing means (i.e. "public/private key pair generator" for preparing an encrypted public key pair (see col. 4, lines 34-36), private key holding means (i.e. "cryptographic cards") for holding a private key out of the public key pair prepared by the encrypted public key pair preparing means, wherein the verification information is a public key prepared by the encrypted public key pair preparing means, and the booking certificate is prepared by using the private key held by the private key holding means (see col. 6, lines 11-25).

Referring to claim 9, Vaeth et al. disclose receiving a first request for booking certificate, which is a request for the issuance of a booking certificate certifying the advance booking of a specific product and/or service, preparing a second request for booking certificate, which is a request for the issuance of the booking certificate request with the accepted first request for

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booking certificate and outputting the second request for booking certificate thus prepared (see col. 6, lines 13-25 and col. 8, lines 6-13). Note, the examiner interprets the first and second request as one request; that is, a request for a booking certificate.

Referring to claim 10, Vaeth et al. disclose booking certificate request acceptance means for accepting a first request for booking certificate, which is a request for the issuance of a booking certificate for certifying the booking in advance for a specific product and/or service that is offered for supply, booking certificate request preparing means for preparing a second request for booking certificate requesting the issuance of a booking certificate requested with the accepted first request for booking certificate and booking certificate request output means for outputting the second request for booking certificate generated by the booking certificate request preparing means (see col. 6, lines 13-25 and col. 8, lines 6-13). Note, the examiner interprets the first and second request as one request; that is, a request for a booking certificate.

Referring to claim 11, Vaeth et al. disclose verification information needed for verifying the legitimacy of a specific booking certificate (i.e. "verification or qualification data". Vaeth et al. do not expressly disclose the certificate is associated with a specific product and/or service, and the first and second requests for booking certificates contain information for identifying the verification information for specifying the product and/or service for which a booking certificate is requested with the requests. However, the examiner notes that the step of associating the certificate with a specific product and/or service is old and well known in the art. That is, when one make online purchases [whether for advance services or not], the consumer is given a ticket/certificate that identifies the service he or she purchased. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system

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disclose by Vaeth et al. to include the certificate is associated with a specific product and/or service, and the first and second requests for booking certificates contain information for identifying the verification information for specifying the product and/or service for which a booking certificate is requested with the requests. One of ordinary skill in the art would have been motivated to do this because it is a conventional method that provides proof-of-purchase.

Referring to claim 20, Vaeth et al. disclose storing verification information for verifying the booking certificate, inputting the booking certificate and verifying the legitimacy of the input booking certificate by using the stored verification information (see col. 4, lines 34-36; col. 6, lines 11-25).

Referring to claim 21, Vaeth et al. disclose verification information storage means for storing verification information for verifying the booking certificate and booking certificate verification means, to which the booking certificate is inputted, for verifying the legitimacy of the input booking certificate by using the verification information stored in the verification information storage means (see col. 4, lines 34-36; col. 6, lines 11-25).

Referring to claim 22, Vaeth et al. disclose connection means for connecting a portable memory apparatus holding the booking certificate, wherein the booking certificate verification means verifies through the connection means the legitimacy of the booking certificate stored in the portable memory apparatus (see col. 4, lines 34-36; col. 6, lines 11-25, 33-52).

7. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vaeth et al. as applied to claim 2 above, and further in view of US Patent No. 6189146 to Misra et al.

Vaeth et al. disclose preparing means for preparing a certificate (see claim 2 above).

Vaeth et al. do not expressly disclose booking conditions preparing means for preparing booking

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conditions, which are conditions for limiting booking particulars, wherein the booking certificate prepared by the booking certificate preparing means contains the booking conditions prepared by the booking conditions preparing means. Misra et al. disclose booking conditions preparing means for preparing booking conditions, which are conditions for limiting booking particulars, wherein the booking certificate (i.e. "license") prepared by the booking certificate preparing means contains the booking conditions prepared by the booking conditions preparing means (see col. 10, lines 60-67; col. 11, table 5; col. 2, lines 16-20). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Vaeth et al. to include booking conditions preparing means for preparing booking conditions, which are conditions for limiting booking particulars, wherein the booking certificate prepared by the booking certificate preparing means contains the booking conditions prepared by the booking conditions preparing means. One of ordinary skill in the art would have been motivated to do this because it provides means for restricting and prohibiting unauthorized certificate holders from utilizing the certificate; also, it assure certificate holders are in compliance with the terms of the certificate (see Misra et al. col. 2, lines 6-10).

Referring to claim 4, Vaeth et al. disclose a booking certificate (see claim 2 above). Vaeth et al. do not expressly disclose preparing means receives input of information for identifying an intermediary of a request for booking certificate, together with the information for identifying verification information, and a booking certificate intermediation license certifying that he intermediary is licensed to intermediate the request for booking certificate corresponding to the verification information thus identified, checks whether or not the intermediary is licensed for intermediation of the request for booking certificate intermediation license, and prepares the

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booking certificate only when the intermediary is found to be licensed. Misra et al. disclose preparing means receives input of information for identifying an intermediary of a request for booking certificate, together with the information for identifying verification information, and a booking certificate intermediation license certifying that he intermediary is licensed to intermediate the request for booking certificate corresponding to the verification information thus identified, checks whether or not the intermediary is licensed for intermediation of the request for booking certificate intermediation license, and prepares the booking certificate only when the intermediary is found to be licensed (see col. 6, lines 31-35, 55-60). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Vaeth et al. to include preparing means receives input of information for identifying an intermediary of a request for booking certificate, together with the information for identifying verification information, and a booking certificate intermediation license certifying that he intermediary is licensed to intermediate the request for booking certificate corresponding to the verification information thus identified, checks whether or not the intermediary is licensed for intermediation of the request for booking certificate intermediation license, and prepares the booking certificate only when the intermediary is found to be licensed. One of ordinary skill in the art would have been motivated to do this because the intermediary can be used to provide resources to clients (see Misra et al. col. 2, lines 22-31).

8. Claims 12 -15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vaeth et al. as applied to claim 10 above, and further in view of Misra et al.

Vaeth et al. disclose preparing means for preparing a certificate (see claim 10 above).

Vaeth et al. do not expressly disclose booking conditions preparing means for preparing booking

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conditions to be contained in the requested booking certificate, wherein the second request for booking certificate prepared by the booking certificate request preparing means contains the booking conditions prepared by the booking conditions preparing means. Misra et al. disclose booking conditions preparing means for preparing booking conditions to be contained in the requested booking certificate, wherein the second request for booking certificate prepared by the booking certificate request preparing means contains the booking conditions prepared by the booking conditions preparing means (see col. 10, lines 60-67; col. 11, table 5; col. 2, lines 16-20). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Vaeth et al. to include booking conditions preparing means for preparing booking conditions to be contained in the requested booking certificate, wherein the second request for booking certificate prepared by the booking certificate request preparing means contains the booking conditions prepared by the booking conditions preparing means. One of ordinary skill in the art would have been motivated to do this because it provides means for restricting and prohibiting unauthorized certificate holders from utilizing the certificate; also, it assure certificate holders are in compliance with the terms of the certificate (see Misra et al. col. 2, lines 6-10).

Referring to claim 13, Vaeth et al. disclose a booking certificate (see claim 10 above). Vaeth et al. do not expressly disclose booking certificate intermediation license storage means for holding a booking certificate intermediation license to certify that the system is licensed for intermediation of the request for booking certificate regarding the specific product and/or service, wherein: the second request for booking certificate, outputted from the booking certificate request output means contains the booking certificate intermediation license to

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intermediate the request for the booking certificate regarding the specific product and/or service. Misra et al. disclose booking certificate intermediation license storage means for holding a booking certificate intermediation license to certify that the system is licensed for intermediation of the request for booking certificate regarding the specific product and/or service, wherein: the second request for booking certificate, outputted from the booking certificate request output means contains the booking certificate intermediation license to intermediate the request for the booking certificate regarding the specific product and/or service (see col. 2, lines 16-21; col. 5, lines 3-12, 26-32; col. 6, lines 31-45). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Vaeth et al. to include booking certificate intermediation license storage means for holding a booking certificate intermediation license to certify that the system is licensed for intermediation of the request for booking certificate regarding the specific product and/or service, wherein: the second request for booking certificate, outputted from the booking certificate request output means contains the booking certificate intermediation license to intermediate the request for the booking certificate regarding the specific product and/or service. One of ordinary skill in the art would have been motivated to do this because intermediary can be used to provide resources to the proper clients (see Misra et al. col. 2, lines 22-31).

Referring to claims 14 and 15, Vaeth et al. discloses an intermediation system (see claim 10 above). Vaeth et al. do not expressly disclose billing means for charging a fee for booking certificate issuance to the requester of the first request for booking certificate, wherein the prescribed booking certificate issuance fee is charged by the billing means to the requester when the first request for booking certificate is inputted, account settlement means for collecting a fee

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for booking certificate issuance from the requester of the first request for booking certificate, wherein the booking certificate issuance fee is collected by the account settlement means from the requester when the first request for booking certificate is inputted. Misra et al. disclose billing means for charging a fee for booking certificate issuance to the requester of the first request for booking certificate, wherein the prescribed booking certificate issuance fee is charged by the billing means to the requester when the first request for booking certificate is inputted, account settlement means for collecting a fee for booking certificate issuance from the requester of the first request for booking certificate, wherein the booking certificate issuance fee is collected by the account settlement means from the requester when the first request for booking certificate is inputted (see col. 2, lines 32-36). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Vaeth et al. to include billing means for charging a fee for booking certificate issuance to the requester of the first request for booking certificate, wherein the prescribed booking certificate issuance fee is charged by the billing means to the requester when the first request for booking certificate is inputted, account settlement means for collecting a fee for booking certificate issuance from the requester of the first request for booking certificate, wherein the booking certificate issuance fee is collected by the account settlement means from the requester when the first request for booking certificate is inputted. One of ordinary skill in the art would have been motivated to do this because it ensures that the vendor is paid for the product/service provided.

9. Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Misra et al.

Misra et al. disclose inputting information for identifying an intermediary to perform intermediation of a request for booking certificate of a product and/or a service, inputting

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information for specifying the product and/or service for which the intermediary is licensed for intermediation, preparing a booking certificate intermediation license for certifying that the intermediation of the request for booking certificate for the product and/or service specified by the latter input information is licensed to the intermediary identified by the former input information and outputting the booking certificate intermediation license certificate thus prepared (see col. 6, lines 31-45, 50-60).

Referring to claim 17, Misra et al. disclose booking certificate intermediation license preparing means, to which information for identifying an intermediary to perform intermediation of a request for booking certificate and information for specifying a product and/or a service for which the intermediary is licensed for intermediation are inputted, for preparing a booking certificate intermediation license for certifying that the intermediary identified by the former input information is licensed for the intermediation of the request for booking certificate for the product and/or service specified by the later input information and booking certificate intermediation license output means for outputting the booking certificate intermediation license prepared by the booking certificate intermediation license preparing means (see col. 5, lines 31-45, 50-60).

Referring to claim 18, Misra et al. disclose booking conditions limitation information preparing means for preparing booking conditions limitation information, which is information for limiting the scope of the booking conditions, which are conditions for limiting booking particular to be entered in the booking certificate issued by intermediation by the intermediary, who is the recipient of the license, wherein the booking certificate intermediation license prepared by the booking certificate intermediation license preparing means contains the booking

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conditions limitation information prepared by the booking conditions limitation information preparing means (see col. 10, lines 60-67; col. 11, table 5; col2, lines 16-20).

Allowable Subject Matter

10. Claims 5-7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 703-305-0057. The examiner can normally be reached on Mondays-Thursdays 8:30 - 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306, 703-746-9443 for Non-Official/Draft .

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks
PO Box 1450
Alexandria, VA 22313-1450***


Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, V.A., Seventh floor receptionist.

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September 22, 2003



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